

REMARKS

With entry of this amendment, claims 80-116 are pending in this application, all of which have been newly added. Claims 34-39 and 68-79 have been cancelled from this application. Based upon the amendment to this application and the following remarks, reconsideration of the application is respectfully requested.

New Claims 80-116

Applicants submit that newly added claims 80-116 are supported by the specification, as originally filed, and are patentable over the prior art of record. To aid the Examiner in examining the new claims, Applicants would like to point out that independent claim 80 is similar to now cancelled independent claim 34, with the exception that claim 80 has been clarified to more clearly define what Applicants regard as their invention. Independent claim 87 is similar to independent claim 80, with the exception that it requires the card body to be PCMCIA compliant.

---

Independent claim 95 is similar to independent claim 80, with the exception that it requires the dimensions of the cavity and the receptacle to differ. Independent claim 107 is similar to independent claim 80, with the exception that it requires the card body to contain communication signal processing circuitry.

Examiner's Bases for Prior Art Rejections Made in Final Office Action

In the previous Final Office Action, dated July 6, 2001, the Examiner rejected the now cancelled claims 34-39 and 68-79 over various combinations of U.S. Patent No. 5,183,404 to Aldous et al. ("Aldous"), U.S. Patent No. 4,611,875 to Clarke et al. ("Clark"), U.S. Patent No. 4,241,974 to Hardesty ("Hardesty"), and a research disclosure entitled "Integrated Services Digital Network (ISDN) Cable Terminator/Filter Device," and published by Kenneth Mason

Publications Ltd., England in September 1990 ("Research Disclosure"). Although claims 34-39 and 68-79 are now cancelled, to expedite the prosecution of this application, Applicants will incorporate the remarks made in the unentered Amendment and Response After Final, dated September 6, 2001, to the extent that such remarks apply to newly added claims 80-116.

Applicants would like to emphasize that their contribution in first recognizing that there was a problem in the PCMCIA connector device prior art, and then developing an elegant solution to address this problem, should not be ignored. M.P.E.P. 2141.02 ("[A] patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified. This is part of the 'subject matter as a whole' which should always be considered in determining the obviousness of an invention under 35 U.S.C. §103.") (emphasis in original). Specifically, Applicants recognized that connector device receptacles that received RJ-xx plugs were often broken and damaged, thus resulting in the entire connector device being discarded and replaced. (Specification, page 4, lines 13-15).

---

Posed with this problem, Applicants came up with a solution by developing various types of removable bodies and housings that are configured to receive RJ-xx plugs, which if broken or damages, can be easily replaced without replacing the entire connector device.

Applicants maintain that there is no suggestion to use the adapters disclosed in Clark, Hardesty, or the Research Disclosure, to improve the Fig. 7 Aldous connector device (or any device disclosed in Aldous) to solve the above-mentioned problem, or for that matter, any problem. First, the adapters disclosed in the cited references cannot be considered an equivalent to the DAA adapter assembly used in the Fig. 7 connector device, since such adapters do not have DAA functionality, thereby rendering the modified Aldous device unsatisfactory for its intended purpose. M.P.E.P. 2143.01 ("If proposed modification would render the prior invention

being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification”).

Second, the teachings of the cited references not only address entirely different problems irrelevant to PCMCIA connector devices (or any connector device used in a computer), but the adapters disclosed in these cited references are unsuitable for use in PCMCIA connector devices. Specifically, Hardesty discloses a multi-outlet adapter for telephone cords, which is plugged into a wall terminal to allow simultaneous connection to two telephone cords (see Abstract). Because there is no apparent reason to provide a PCMCIA card that has the capability of simultaneously connecting to two telephone lines, there is no suggestion to use the Hardesty adapter in any of the Aldous connector devices. The only apparent way to use the Hardesty adapter with an Aldous connector device is to connect a telephone line between them, which would result in a device completely different from the claimed invention.

As for Clarke, it discloses a power adapter for supplying power to a telephone station (see Abstract). Because power is provided to PCMCIA cards via the device in which they are installed, there is no suggestion to use the Clarke power adapter with any of the Aldous connector devices. Lastly, the Research Disclosure discloses an ISDN cable terminator/filter device that is used to provide ISDN services. It appears from its disclosure that the ISDN device is to be plugged into a wall unit to provide ISDN service and filtering for ISDN telephones. There is no suggestion to use that ISDN device with any of the Aldous connector devices, and, like the Hardesty adapter, the only apparent way to use the ISDN device with an Aldous connector device is to connect a telephone line between them (assuming that the Aldous connector device has ISDN functionality at all), which will produce a resulting assembly that is different from the claimed invention.

Thus, Applicants believe that claims 80-116 are not obvious in view of Aldous in combination with either Hardesty, Clarke, or the Research Disclosure.

Examiner's Further Basis for Prior Art Rejection Set Forth in Advisory Action

In the Advisory Action, dated, September 25, 2001, the Examiner further added that the Fig. 8 PCMCIA card of Hardesty is more clearly usable with the adapter devices of Hardesty, Clarke, and the Research Disclosure, and that such adapter devices are used to change type or size of the socket. Applicants maintain that regardless of whether such adapter devices change the type or size of the socket, there is still no suggestion that these adapters can be used with the Hardesty card, and there is not apparent reason to do so, as described above. Thus, Applicants maintain that claims 80-116 are not obvious in view of Aldous, Hardesty, Clarke, and the Research Disclosure.

Conclusion

Based upon the foregoing amendments and remarks, it is respectfully submitted that, with entry of this amendment, the application is in condition for allowance. Should the Examiner have any questions or comments, he is invited to call the undersigned at (949) 567-2300.

Respectfully submitted,  
LYON & LYON

Dated: December 26, 2001

By: 

Michael J. Bolan  
Reg. No. 42,339  
Attorneys for Applicants

MJB/dmd  
633 W. Fifth Street, Suite 4700  
Los Angeles, California 90071  
(949) 567-2300 or (213) 489-1600